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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,500	03/29/2002	Nobuo Hanai	249-255	9448

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ARLINGTON, VA 22203

EXAMINER

BLANCHARD, DAVID J

ART UNIT	PAPER NUMBER
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1643

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/089,500

Applicant(s)

HANAI ET AL.

Examiner

David J. Blanchard

Art Unit

1643

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 23 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 +2 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1, 2, 6, 9-13, 15, 16, 20-28, 30-32, 36-41, 48, 50, 51, 55-58 and 62.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: The reply filed 1/23/2006 has changed the scope of the claims and entry of the amendment would raise new issue, requiring new considerations, new search and new rejections. For example, claim 1 as presently amended and newly added claim 63 combine the CDRs of SEQ ID Nos:3-8 with the humanized heavy chain variable region of SEQ ID NO:9 or the light chain variable region of SEQ ID NO:54, which raises a scope issue under the second paragraph 35 U.S.C. 112 as it is unclear what the claimed humanized antibody comprises since SEQ ID Nos:9 and 54 appear to already contain the CDRs of SEQ ID Nos:3-8. Are the CDRs in addition to the heavy and light chain variable regions of SEQ ID Nos:9 and 54? Amending the claims as being drawn to a humanized antibody comprising the heavy chain variable region of SEQ ID NO:9 and/or a light chain variable region of SEQ ID NO:54 would obviate this scope issue. Additionally, claims 1 and 63 as presented introduce new matter. The as filed disclosure does not provide adequate written support for humanized antibody comprising the heavy chain variable region CDRs of SEQ ID Nos:3-5 and the light chain variable region CDRs of SEQ ID Nos:6-8 AND a heavy chain variable region comprising SEQ ID NO:9 or a light chain variable region comprising SEQ ID NO:54 as presently amended. Applicant can obviate this rejection by specifically pointing out where support for the presently amended claims can be found in the disclosure as filed. Further, claim 41 does not further limit the subject matter of a previous claim and would be objected to under 37 CFR 1.75(c). Claim 41 recites that the antibody conjugate comprises the heavy chain variable region of SEQ ID NO:53, which is not recited in any of the base claims from which claim 41 depends. Any claim which is in dependent form but which is so worded that it, in fact is not, as, for example, it does not include every limitation of the claim on which it depends, will be required to be canceled or amended as not being a proper dependent claim.

The reply filed 1/23/2006 does not overcome the rejection of claim 32 under 35 U.S.C. 112, second paragraph as being indefinite in the recitation of "derivative" and also for lack of antecedent basis for "The derivative".

As an additional matter, Applicant's attention is directed to claim 33, which has been omitted from the amendment filed 1/23/2006. See 37 CFR 1.126.

Continuation of 5. Applicant's reply has overcome the following rejection(s): If, if, if entered, the reply filed 1/23/2006 appears to overcome all grounds of rejections set forth in the previous Office Action mailed 8/22/05, not discussed above.

Respectfully,  
David J. Blanchard  
571-272-0827



SHEELA HUFF  
PRIMARY EXAMINER